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RE: OFFICIAL PAPER
TO: Examiner **Brandon S. Hoffman**
U.S. Patent and Trademark Office
GAU: 2136
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FROM: Kenneth M. Brown
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DATE: October 4, 2007
Pages (incl. Cover): 5

Re: **AFTER FINAL**
Response to Final Office Action and Request For Reconsideration

Case No: **Burch 2-9**

Serial No: **09/901,286**

File Date: **July 9, 2001**

Title: **Methods And Apparatus For Tracing Packets In A Communications Network**

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Date: 10-4-07 *[Signature]*
Sue Sabou

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Hal Joseph Burch
William R CheswickRECEIVED
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CASE 2-9

Serial No. 09/901286

Group Art Unit 2136

Filed July 9, 2001

Examiner B. S. Hoffman

Title Method And Apparatus For Tracing Packets In A Communications Network

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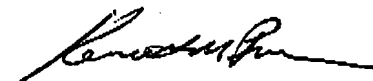
SIR:

Enclosed is a Response to Final Office Action and Request for Reconsideration in the above-identified application.

NO ADDITIONAL FEE REQUIRED

In the event of non-payment or improper payment of a required fee, the Commissioner is authorized to charge or to credit Deposit Account No. 12-2325 as required to correct the error.

Respectfully,


Kenneth M. Brown, Attorney
Reg. No. 37590
908-582-5998.

Date: 10/4/07

Docket Administrator (Room 2F-192)
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10/4/07



Ser. No. 09/901,286

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICERECEIVED
CENTRAL FAX CENTER
OCT 04 2007**Patent Application**

Inventor(s) Hal Joseph Burch
William R Cheswick

Case 2-9

Serial No. 09/901,286 Group Art Unit 2136

Filing Date July 9, 2001

Examiner Brandon S. Hoffman

Title Method And Apparatus For Tracing Packets In A Communications Network

COMMISSIONER FOR PATENTS
P.O. Box 1450
ALEXANDRIA, VA 22313-1450

SIR:

RESPONSE TO FINAL OFFICE ACTION AND REQUEST FOR RECONSIDERATION

In connection with the above-referenced patent application, and in response to the Office Action dated July 13, 2007 in connection therewith, Applicants hereby traverse all outstanding rejections and, in particular, point out that the "Response to Arguments" section of the instant Office Action has incorrectly applied the law regarding Applicants' previously filed Declaration under 37 C.F.R. 1.131 (hereinafter "the Declaration"). As such, Applicants respectfully request withdrawal of the instant Final Office Action and request reconsideration of the instant application.

In the instant application, claims 1-30 are pending. In the instant Office Action, claims 1-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,032,020 issued on April 18, 2006 to G. W. Gross (hereinafter "*Gross*") in view of U.S. Patent No. 6,873,600 issued on March 29, 2005 to N. G. Duffield *et al.* (hereinafter "*Duffield et al.*"). In connection with a previous response to a previous Office Action, Applicants submitted the Declaration, which was executed by both inventors of the instant application and which clearly overcomes the outstanding

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rejection by proving a date of conception *and reduction to practice* prior to the effective date of the *Gross* reference (March 30, 2001). In particular, the Declaration includes as an exhibit thereto a copy of a published paper entitled "Tracing Anonymous Packets to Their Approximate Source" (hereinafter "the Paper") by Hal Burch and Bill Cheswick (the inventors of the instant application), which paper was published on or before December 8, 2000 in Proceedings of the 14th Systems Administration Conference (LISA 2000), New Orleans, Louisiana, USA, December 3-8, 2000, USENIX Association. The Declaration states and proves that the instant invention was conceived *and reduced to practice prior* to December 22, 2000, and that the publication of the Paper on or before December 8, 2000 evidences these facts, based on the paper's content which clearly shows not only a conception of the instant invention, but also test results which show the existence of a reduction to practice thereof. Specifically, therefore, Applicants note that, since the publication date of the Paper clearly precedes the effective date of the *Gross* reference, both conception *and reduction to practice* of the instant invention have been demonstrated to have been performed prior to the effective date of the *Gross* reference.

The instant Office Action, however, in the section titled "Response to Arguments" in paragraph 5 on page 7 thereof, fully agrees with the Applicants that conception of the invention *and* reduction to practice thereof have been successfully shown by the Applicants, but then goes on to allege that the Declaration is deficient because "Applicant has not, however, shown any form of diligence from the date of publication of the document, December 8, 2000, to the actual filing date of the application in the United States, July 9, 2001." (See instant Office Action, paragraph 5, subsection c, on page 7 thereof.) But, it is, of course, well settled law that diligence is only required to be shown between the conception of an invention and its (actual or constructive) reduction to practice. Once the invention has been reduced to practice, as this invention has been shown to have been by December 8, 2000, there is no requirement whatsoever that diligence be shown after that point in time. (Diligence up to the date of filing of an application only needs to be shown where prior conception only, but not an actual reduction to practice, has been demonstrated, since the filing of the application can be relied on as being a "constructive" reduction to practice.) As such, the instant Office Action's rejection of the Declaration as being insufficient to overcome the *Gross* reference and the outstanding rejection of the instant claims resulting therefrom is clearly contrary to the law and clearly incorrect.


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On October 3, 2007, Applicants' undersigned attorney and the Examiner had a telephone conversation in which the Examiner, having previously consulted with other key USPTO senior examiners, fully agreed with the Applicants' attorney that the instant Final Office Action is incorrect and that the *Gross* reference has, in fact, been successfully antedated by the Declaration. Applicants' attorney wishes to thank the Examiner for his verbally expressed admission of the mistake in the outstanding Office Action, and hereby provides this submission to rectify this error.

In summary therefore, for the above described reasons, Applicants respectfully submit that the *Gross* reference has been antedated by the Declaration and is thus no longer admissible prior art to the instant invention. Moreover, Applicants submit that the *Duffield et al.* reference alone does not anticipate nor by itself render obvious any of the instant claims, given the required removal of the *Gross* reference as prior art. Thus, Applicants hereby traverse all of the outstanding rejections of the instant claims, submitting that a *prima facie* case of unpatentability has not, in fact, been made by the Examiner, and Applicants further respectfully request withdrawal of the instant Final Office Action and submit that the instant application is in condition for allowance.

Reconsideration of this application is respectfully requested in light of this submission. The Examiner is invited to telephone Applicant's attorney, Kenneth M. Brown, at (908) 582 - 5998, should there be any questions or issues for discussion in the reconsideration of the pending application.

Respectfully,

Hal Joseph Burch
William R CheswickBy 
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Lucent Technologies Inc.

Date: 10/3/07